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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
09/865,230	05/25/2001	Nicholas J. Elsey	41698.1007	2619	
7590	01/26/2006		EXAMINER HOOSAIN, ALLAN		
Alex L. Yip Kaye Scholer LLP 425 Park Avenue New York, NY 10022			ART UNIT		PAPER NUMBER
			2645		

DATE MAILED: 01/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/865,230

Applicant(s)

ELSEY ET AL.

Examiner

Allan Hoosain

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 13-18 and 92-96 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-18 and 92-96 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>See Continuation Sheet</u> .           |

Continuation of Attachment(s) 6). Other: The amendments to the Drawings and the Specification were not entered.

## **FINAL DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. Claim 18 is rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. 'Update of the first information source ...' critical or essential to the practice of the invention, included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

2. Claim 18 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There does not appear to be a written description of the limitation "update of the first information source is halted while the system is drawing power from the battery power source" in the application as filed.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. Claims 13-15,17,92-94,96 rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Miner et al.** (US 5,652,789).

As to Claims 13,92, with respect to Figures 28-30, **Miner** teaches a system for managing at least contacts (first) and persons (second) information sources comprising:

- a memory for storing data concerning an association of the first information source with the second information source (Figure 1);

- a device for selecting at least one direction of a flow of information between the first information source and the second information source (Figure 1, labels 16,18);

- an interface for accessing at least one of the first information source and the second information source through a communication connection (Figure 5 and Figure 28); and

- a processor for updating at least the first information source with information in the second information source in accordance with the direction (Col. 38, lines 52-65, Figure 28 and Figure 2, label 42).

As to Claims 14,93, **Miner** teaches the system of claim 13 wherein the first and second information sources contain contacts information (Figure 1).

As to Claims 15,94, **Miner** teaches the system of claim 13 wherein the first and second information sources contain appointments information (Figures 29-30).

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As to Claims 17,96, **Miner** teaches the system of claim 13 wherein the first information source is updated while the system is idle (Col. 39, lines 59-67).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 16,95 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Miner** in view of **Stuntebeck et al.** (US 6,065,016).

As to Claims 16,95 the system of claim 13 wherein the communication connection includes a WAN (Figure 5);

**Miner** does not teach the following limitation:

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“an Internet connection”

However, it is obvious that **Miner** suggests the limitation. This is because **Miner** teaches connections to a WAN (Col. 11, lines 51-53). **Stuntebeck** teaches the limitation (Figure 1, label 50). Having the cited analogous art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add Internet connection to **Miner**'s invention for accessing directory services as taught by **Stuntebeck**'s invention in order to provide numerous access channels.

### *Response to Arguments*

8. Applicant's arguments filed in the Remarks have been fully considered but they are not persuasive because of the following:

#### 35 USC 112 Rejections:

The argument that it is well known that a personal computer ordinarily contains a battery to provide power to selected components such as the microprocessor is not supportable. The connectivity of the battery in Figure 14 and amendment to the Specification were not entered because they are new matter. The rejections are maintained.

#### 35 USC 102 Rejections

Miner teaches further in Figures 14-15 that when phone numbers are changed all phone books and contacts referencing the user show the new information. Therefore, information does flow between the various information sources of the user.

The argument suggests that Applicants information sources are separate network locations. However, this suggested argument is not directed towards the claims.

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35 USC 103 Rejections

Examiner respectfully believes that these rejections are proper because of the arguments above.

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Stern et al.** (US 6,731,927) teach context association for cellular directory assistance calls.

**Molne** (US 5,689,547) teaches storing requested telephone numbers in radio telephones.

**Cox et al.** (US 6,035,190) teach operator assistance and database access to retrieve requested directory listings.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.



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11. Any response to this final action should be mailed to:

**Box AF**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

(571) 273-8300, (for formal communications; please mark "EXPEDITED  
PROCEDURE")

**Or:**


(703) 306-0377 (for customer service assistance)

Hand-delivered responses should be brought to Carlyle, Alexandria,  
VA 22313 (Receptionist).

Any inquiry concerning this communication or earlier communications from the  
examiner should be directed to **Allan Hoosain** whose telephone number is (571) 272-7543. The  
examiner can normally be reached on Monday to Friday from 8 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
supervisor, **Fan Tsang**, can be reached on (571) 272-7547.

Any inquiry of a general nature or relating to the status of this application or proceeding  
should be directed to the Group receptionist whose telephone number is (571) 272-2600.

  
**Allan Hoosain**  
**Primary Examiner**  
1/23/06